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Jaw



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Lijun Wu and Charles R. MacKay  
Application No.: 09/870,932 Group: 1647  
Filed: May 30, 2001 Examiner: Sharon L. Turner  
Confirmation No.: 9497  
For: Anti-CCR5 Antibodies and Kits Comprising Same (Amended)

CERTIFICATE OF MAILING OR TRANSMISSION	
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REPLY TO ELECTION REQUIREMENT

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Responsive to the Election Requirement dated June 15, 2004, the species of chemokine elected for prosecution is RANTES.

The requirement is being traversed for the reasons set forth in detail below.

**Traversal of the Restriction Requirement**

The Examiner states that:

[t]his requirement is deemed necessary for examination purposes due to the introduction of the *new limitations directed toward the specificity of the antibodies and antibody fragments to the different chemokines* and arguments of record that the various chemokines are subject to different specific receptor binding parameters and hence the antibodies and antigen binding fragments thereof provide for different regional antibody binding/inhibiting specificity (Office Action, page 3, emphasis added).

Applicants respectfully disagree. The Examiner is respectfully requested to specify where arguments of record have been made that state that the chemokines MIP-1 $\alpha$ , MIP- $\beta$  and RANTES are subject to different specific receptor binding parameters and hence the antibodies and antigen binding fragments thereof provide for different regional antibody binding/inhibiting specificity.

In addition, Applicants' claim limitations are not directed toward the specificity of the antibodies and antibody fragments *to the different chemokines*. Instead, Applicants' claimed antibody or antigen binding fragment thereof binds *to chemokine receptor 5 (CCR5)*. Applicants' amendment filed on January 30, 2004, presented new claims wherein the claimed antibody or fragment thereof binds to a *human* chemokine receptor 5 (compare, for example, former Claim 75 and new Claim 147).

Furthermore, the chemokines MIP-1 $\alpha$ , MIP- $\beta$  and RANTES are not new limitations. The chemokines MIP-1 $\alpha$ , MIP- $\beta$  and RANTES were presented in the *originally filed* claims, see, for example, Claims 31 and 34. Responsive to the Restriction Requirement mailed from the United States Patent and Trademark Office on September 13, 2002, Applicants elected Group I (corresponding to Claims 1-7, 27-32, 47-52 and 55-56) on October 15, 2002. Claim 31 claimed, *inter alia*, chemokines MIP-1 $\alpha$ , MIP- $\beta$  and RANTES. Applicants also submitted a second Preliminary Amendment with the Reply to Restriction Requirement that cancelled Claims 1-73

and added Claims 75-110. The newly added claims also claimed, *inter alia*, chemokines MIP-1 $\alpha$ , MIP- $\beta$  and RANTES (see, for example, Claims 78, 90 and 102). Claims 75-110 were ***entered and examined*** in an Office Action dated January 10, 2003. Claims 75-110 were ***further examined*** in a second Office Action mailed from the United States Patent and Trademark Office on June 25, 2003.

As stated in the MPEP:

Election of species should be required ***prior to a search on the merits*** (A) in all applications containing claims to a plurality of species with no generic claims, and (B) in all applications containing both species claims and generic or Markush claims.

In all applications in which no species claims are present and a generic claim recites such a multiplicity of species that an unduly extensive and burdensome search is required, a requirement for an election of species should be made prior to a search of the generic claim (MPEP § 808.01(a) emphasis added).

Clearly, claims reciting the species of chemokines, namely MIP-1 $\alpha$ , MIP- $\beta$  and RANTES, have already been searched and examined in the present application. Reconsideration and withdrawal of the Election Requirement are respectfully requested.

#### **Interview Summary**

Applicants' representatives thank the Examiner for conducting a telephonic interview on July 8, 2004, in which the Election Requirement was discussed. Applicants' representatives indicated that a response to the election requirement would be filed, electing a species, and traversing the Election Requirement. The Examiner indicated that Applicants' request for withdrawal of the Election Requirement would be considered in view of Applicants' response to the Election Requirement.

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**CONCLUSION**

In view of the above remarks, it is believed that all claims are in condition for allowance, and it is respectfully requested that the application be passed to issue. If the Examiner feels that a telephone conference would expedite prosecution of this case, the Examiner is invited to call the undersigned.

Respectfully submitted,

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